REMARKS

Claims 1-16 are currently pending in the subject application, and are presently under consideration. Claims 1-16 are rejected. Favorable reconsideration of the application is requested in view of the comments herein.

I. Rejection of Claims 1-2 and 9-10 Under 35 U.S.C. §103(a)

Claims 1-2 and 9-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,878,138 to Yacobi ("Yacobi") in view of Texas Department of Public Safety Frequently Asked Questions. October 12, 1999 pages 1-4. Retrieved from the Internet at the following URL: http://web.archive.org/web/2000303141313/www.txdps.state.tx.us /administration/driver_licensing_control/faq.htm ("Texas DPS"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 1 recites a method of preventing ID spoofing in a public key infrastructure (PKI) system that includes allowing a user to access a registration server, upon the registration server receiving identification information form the user and also receiving a request by the user for a new signature certificate, the registration server querying a directory containing reference information of users of an enterprise to obtain information regarding the identified user and upon the registration server receiving information from the directory indicating that the identified user already possess a signature certificate, the registration server informing the user that a new signature certificate will not be issued until the old signature certificate has been revoked, thereby preventing an unauthorized user from ID spoofing to obtain a valid signature certificate and maintaining a one-to-one correspondence between users of the enterprise and signature certificates.

The Examiner contends that Yacobi in view of Texas DPS renders claim 1 obvious. This contention is respectfully traversed. As admitted in the Office Action, Yacobi fails to teach or suggest a registration server informing a user that a new signature certificate will not be issued until the old signature certificate has been revoked, as recited in claim 1. The addition of a

second reference, namely, Texas DPS, does not cure the deficiencies of Yacobi. Texas DPS also does not teach or suggest a registration server informing a user that a new signature certificate will not be issued until the old signature certificate has been revoked, as recited in claim 1. Texas DPS discloses that in order for a person to get a Texas driver's license, that person will be required to surrender his/her valid or expired Out-of-State driver's license (See Texas DPS Page 1). A driver's license (from any State) is not a signature certificate. A signature certificate is a form of a digital certificate. A digital certificate contains information identifying the owner of a key pair, a public key of the key pair, and a period for which the certificate is valid (See Spec., Para. [0004]). There is no teaching or suggestion in Texas DPS that a driver's license contains a public key of a key pair, like the signature certificate recited in claim 1. Thus, Texas DPS does not teach or suggest informing a user that a new signature certificate will not be issued until the old signature certificate has been revoked, as recited in claim 1. Accordingly, Yacobi and Texas DPS do not teach or suggest each and every element of claim 1.

Additionally, it is respectfully submitted that there is no motivation to combine and modify the teachings of Yacobi and Texas DPS in the manner suggested by the Office Action. The U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") has held that obviousness cannot be established by combing the teachings of the prior art to produce the claimed invention absent some teaching suggestion or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). In the instant application, it appears that the rejection of claim 1 uses improper hindsight wherein the application provides the missing motivation to combine the teachings of Yacobi and Texas DPS. The Office Action provides no reason why one of ordinary skill in the art of PKIs would look combine the teachings of Yacobi with the teachings of Texas DPS. The method recited in claim 1 prevents ID spoofing by maintaining a one-to-one correspondence between users of an enterprise and signature certificates. Texas DPS, on the other hand, does not teach or suggest any use of signature certificates. Accordingly, one of ordinary skill in the art would not look to combine and modify the teachings of Yacobi and Texas DPS in the manner suggested by the Office Action.

Furthermore, it is respectfully submitted Texas DPS is non-analogous art. The Federal Circuit has held that in order for cited art to be analogous to maintain a prima facie case of obviousness, the cited art must either be in the same field of endeavor or reasonably pertinent to the problem the inventor attempted to solve. *Wang Lab., Inc. v. Toshiba Corp.*, 993 F.2d 858, 863, 26 U.S.P.Q.2d 1767, 1773 (Fed. Cir. 1993).

As stated above, the first part of the analogous art test set up by the Federal circuit requires that the cited art must be in the same field of endeavor. The method recited in claim 1 relates to a method of preventing ID spoofing in a PKI system that maintains a one-to-one correspondence between users of an enterprise and signature certificates. The registration server recited in claim 1 is a computer system that can identify users based on data within the signature certificates. Texas DPS relates to driver's licenses. Driver's licenses are not signature certificates. A person can identify the holder of a driver's license by looking at the picture on the driver's license and comparing the picture to the person presenting the license. On the other hand, a computer can only identify the presenter of a signature certificate by executing a computer algorithm. Unlike a driver's license, a person cannot identify the presenter or a signature certificate without the aid of a computer. Thus, claim 1 and Texas DPS are not in the same field of endeavor.

As mentioned above, the second part of the test set up by the Federal circuit is that if the cited art is not in the same field of endeavor as the claimed invention, the cited art must be reasonably pertinent to the problem the inventor attempted to solve. Claim 1 is a method of preventing ID spoofing in PKI. The method recited in claim 1 includes a registration server informing a user that a new signature certificate will not be issued until the old signature certificate has been revoked, thereby preventing an unauthorized user from ID spoofing to obtain a valid signature certificate and maintaining a one-to-one correspondence between users of an enterprise and signature certificates. It is respectfully submitted that Texas DPS does not maintain a one-to-one correspondence between drivers and drivers licenses. In Texas DPS, if a driver claims to have lost his/her drivers license (e.g., either in-state or out-of state), that driver can get a new license (See Texas DPS, Page 1). Thus, a driver in Texas DPS could have

multiple driver licenses that could be used to spoof the identity of the driver, particularly in situations where the person verifying the identity of the presenter had no connection to the Texas Department of Public Safety (*e.g.* a person under the age of 21 using a driver's license of another person to purchase alcohol). Accordingly, Texas DPS is non-analogous art. Consequently, for the reasons stated above, claim 1 should be patentable over the cited art.

Claim 2 depends from claim 1, and is not made obvious by Yacobi in view of Texas DPS for substantially the same reasons as claim 1, and for the specific elements recited therein. Accordingly, reconsideration and allowance of claim 2 is respectfully requested.

Regarding claim 9, as admitted in the Office Action, Yacobi fails to teach or suggest a registration server informing a user that a new signature certificate will not be issued until the old certificate has been revoked, as recited in claim 9. As stated above with respect to claim 1, Texas DPS also fails to teach or suggest a registration server informing a user that a new signature certificate will not be issued until the old certificate has been revoked, as recited in claim 9. Additionally, as stated above with respect to claim 1, Yacobi and Texas DPS provide no motivation for their combination. Furthermore, as mentioned above, Texas DPS is non-analogous art. Thus, Yacobi taken in view of Texas DPS does not make claim 9 obvious. Accordingly, claim 9 should be patentable over the cited art.

Claim 10 depends from claim 9 and is not obvious for substantially the same reasons as claim 9 and for the specific elements recited therein. Accordingly, claim 9 should be patentable over the cited art.

For the reasons described above, claims 1-2 and 9-10 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 5-6 and 13-14 Under 35 U.S.C. §103(a)

Claims 5-6 and 13-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yacobi in view of U.S. Patent No. 6,308,277 to Vaeth ("Vaeth"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 5 recites a method of preventing ID spoofing in a PKI in an enterprise including allowing a user to access a registration server, upon the registration server receiving identification information from the user and also receiving a request by the user for a new signature certificate and upon the registration server receiving information from the directory indicating that the identified user is not in the directory, the registration server informing the user that a signature certificate will not be issued. When claim 5 is read has a whole, it is clear that the user recited in claim 5 does not possess a signature certificate. It is respectfully submitted that in rejecting claim 5, that the Office Action does not read claim 5 "as a whole." The Federal Circuit has held that to support a determination of obviousness the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of *the claimed invention as a whole*, not merely the differences between the claimed invention and the prior art. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, U.S.P.Q. 1024, 1033 (Fed. Cir. 1984).

The Examiner contends that Yacobi taken in view of Vaeth renders claim 5 obvious (See Office Action, Page 4). In rejecting claim 5, the Examiner has alleged that Yacobi discloses allowing a user to access a registration server (See Office Action, Page 4). However, the referenced section of Yacobi discloses a user possessing an electronic wallet with a manufacturer-issued certificate, wherein the user is re-certified, and issued another certificate (See Yacobi, Col. 8, Line 40-Col. 9, Line 23). Yacobi presupposes that any user attempting to have a certificate issued is in possession of an electronic wallet, and therefore, the user is already in possession of a certificate. On the other hand, Yacobi does not teach or suggest that a registration server allows a user without a certificate to access the registration server, as recited in claim 5. Stated another way, in Yacobi, the electronic wallet (that already possess a certificate) acts as a key that allows a user to access a certification authority. Without physical possession of the electronic wallet (and therefore, possession of a certificate) the user cannot request a new certificate. Thus, Yacobi does not teach or suggest allowing a user to access a registration server, as recited in claim 5, when claim 5 is read as a whole.

Additionally, Yacobi also does not teach or suggest upon a registration server receiving identification information from a user and also receiving a request by the user for a new certificate, the registration server querying a directory containing reference information of users of an enterprise to obtain information regarding the identified user, as recited in claim 5. As stated above, when claim 5 is read as a whole, the user recited in claim 5 does not possess a certificate. In contrast, as discussed above, any user requesting a certificate in Yacobi already possesses a certificate. In Yacobi, a bank computer confirms the identity of a user if an electronic wallet's certificate checks out cleanly (See Yacobi, Col. 9, Lines 15-20). Thus, Yacobi does not teach or suggest a registration server receiving identification information from a user and also receiving a request by the user for a new signature certificate, as recited in claim 5.

Furthermore, as admitted in the Office Action, Yacobi fails to teach or suggest that upon a registration server indicating that an identified user is not in a directory, the registration server informing the user that a signature certificate will not be issued, as recited in claim 5 (See Office Action Page 4). The examiner contends that Vaeth cures the deficiencies of Yacobi. Applicant respectfully disagrees with this contention. It is respectfully submitted that one of ordinary skill in the art would not look to combine and modify Yacobi and Vaeth in the manner suggested by the Office Action. As stated above, Yacobi presupposes that any user requesting a certificate is already in possession of a certificate. It would not have been obvious to one of ordinary skill in the art implementing Yacobi to include the step of upon a registration server receiving information from a directory indicating that an identified user is not in a directory, the registration server informing the user that a signature certificate will not be issued, as recited in claim 5. Since Yacobi requires any user that requests a new certificate to be in possession of a current certificate, any bank computer receiving the request for a new certificate would receive the current certificate that would be in the bank computer's database. Accordingly, in Yacobi, there would never be a time when a user requesting a new certificate would not be in possession of a certificate that was not in the bank computer's database. Thus, in Yacobi, there would not be a need to implement the step of a registration server receiving information from a directory

indicating that an identified user is not in a directory, the registration server informing the user that a signature certificate will not be issued, as recited in claim 5.

Further still, in Vaeth, a requestor using a an Internet browser can request a certificate using a certificate request web page (See Vaeth, Col. 7, Lines 55-61). Thus, in Vaeth, any person with an Internet browser can request a certificate. There is no requirement that the requestor possess any special piece of hardware (i.e. an electronic wallet with a certificate, as in Yacobi). Thus, combining the teachings of Vaeth with the teachings of Yacobi would cause the system of Yacobi to be less secure. The Federal Circuit has held that motivation to combine concerns what is desirable, not just what is feasible. *Winner International Royalty Corporation v. Ching-Rong Wang*, 202 F.3d 1340, 1349, 53 U.S.P.Q.2d 1587 (Fed. Cir. 2000). In *Winner International Royalty Corporation*, the Federal Circuit held that one of ordinary skill in the art would not have reasonably elected trading the benefit of security for that of convenience. 202 F.3d 1340, 1349, 53 U.S.P.Q.2d 1587. Thus, in the present application, it is respectfully submitted that one of ordinary skill in the art would not trade the benefit of security offered by Yacobi, by requiring a user requesting a new certificate to possess an electronic wallet, for the convenience offered by Vaeth by allowing anyone with an Internet browser to request a new certificate. Accordingly, it is respectfully submitted that Yacobi and Vaeth lack sufficient motivation of combination to sustain a prima facie case of obvious, with regard to claim 5. Consequently, it is respectfully submitted that claim 5 is patentable over the cited art.

Claim 6 depends from claim 5. Claim 6 is patentable for substantially the same reasons as claim 5, and for the specific elements recited therein. Accordingly, claim 6 should be patentable over the cited art.

Regarding claim 13, Yacobi does not teach or suggest a registration server allowing access by a user, the registration server receiving information from a user and also receiving a request by the user for a new signature certificate, the registration server querying a directory to obtain information from the directory indicating that the user is not in the directory, as recited in claim 13. As with claim 5, when claim 13 is read as a whole, the user requesting a new signature certificate in claim 5 does not possess a signature certificate. As stated above with respect to

claim 5, Yacobi presupposes that the user requesting a new certificate already possess a certificate. Additionally, for the reasons stated above with respect to claim 5, Yacobi and Vaeth lack sufficient motivation for combination to support a prima facie case of obviousness of claim 13. Accordingly, claim 13 should be patentable over the cited art.

Claim 14 depends from claim 13. Claim 14 is patentable for substantially the same reasons as claim 13 and for the specific elements recited therein. Accordingly, claim 14 should be patentable over the cited art.

For the reasons described above, claims 5-6 and 13-14 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 3 and 11 Under 35 U.S.C. §103(a)

Claims 3 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yacobi in view of Texas DPS and in further of Zhou, Tao "*Directory Integration and the Metadirectory*", July 1999, Windows IT Pro ("Zhou"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 3 depends from claim 1. Claim 3 is patentable for substantially the same reasons as claim 1 and for the specific elements recited therein. The additional of a third reference, namely Zhou, does not cure the aforementioned deficiencies of Yacobi in view of Texas DPS. That is, Zhou also does not teach or suggest informing a user that a new signature certificate will not be issued until the old certificate has been revoked, as recited in claim 1, from which claim 3 depends. Accordingly, claim 3 should be patentable over the cited art.

Claim 11 depends from claim 9. Claim 9 is patentable for substantially the same reasons as claim 9 and for the specific elements recited therein. The additional of a third reference, namely Zhou, does not cure the aforementioned deficiencies of Yacobi in view of Texas DPS. That is, Zhou also does not teach or suggest informing a user that a new signature certificate will not be issued until the old certificate has been revoked, as recited in claim 9, from which claim 11 depends. Accordingly, claim 11 should be patentable over the cited art.

For the reasons described above, claims 3 and 11 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 7 and 15 Under 35 U.S.C. §103(a)

Claims 7 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yacobi in view of Vaeth in further view of Zhou. Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 7 depends from claim 5 and is patentable for substantially the same reasons as claim 5 and for the specific elements recited therein. The addition of a third reference, namely Zhou, does not cure the aforementioned deficiencies of Yacobi in view of Vaeth. Zhou also fails to teach or suggest allowing a user to access a registration server, as recited in claim 5, from which claim 7 depends. Accordingly, claim 7 should be patentable over the cited art.

Claim 15 depends from claim 13 and is patentable for substantially the same reasons as claim 13, and for the specific elements recited therein. The addition of a third reference, namely Zhou, does not cure the aforementioned deficiencies of Yacobi in view of Vaeth. Zhou also fails to teach or suggest a registration server to allow access by a user, as recited in claim 13, from which claim 15 depends. Accordingly, claim 15 should be patentable over the cited art.

For the reasons described above, claims 7 and 15 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 4 and 12 Under 35 U.S.C. §103(a)

Claims 4 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yacobi in view of Texas DPS in further view of U.S. Patent No. 5,214,702 to Fischer ("Fischer"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 4 depends from claim 1. Claim 4 is patentable for substantially the same reasons as claim 1 and for the specific elements recited therein. The additional of a third reference, namely Fischer, does not cure the aforementioned deficiencies of Yacobi in view of Texas DPS.

That is, Fischer also does not teach or suggest informing a user that a new signature certificate will not be issued until the old certificate has been revoked, as recited in claim 1, from which claim 4 depends. Accordingly, claim 4 should be patentable over the cited art.

Claim 12 depends from claim 9. Claim 12 is patentable for substantially the same reasons as claim 9 and for the specific elements recited therein. The additional of a third reference, namely Fischer, does not cure the aforementioned deficiencies of Yacobi in view of Texas DPS. That is, Fischer also does not teach or suggest informing a user that a new signature certificate will not be issued until the old certificate has been revoked, as recited in claim 9, from which claim 12 depends. Accordingly, claim 12 should be patentable over the cited art.

For the reasons described above, claims 4 and 12 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

VI. Rejection of Claims 8 and 16 Under 35 U.S.C. §103(a)

Claims 8 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yacobi in view of Vaeth in further view of Fischer. Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 8 depends from claim 5. Claim 8 is patentable for substantially the same reasons as claim 5 and for the specific elements recited therein. The additional of a third reference, namely Fischer, does not cure the aforementioned deficiencies of Yacobi in view of Vaeth. That is, Fischer also fails to teach or suggest allowing a user to access a registration server, as recited in claim 5, from which claim 8 depends. Accordingly, claim 8 should be patentable over the cited art.

Claim 16 depends from claim 13. Claim 16 is patentable for substantially the same reasons as claim 13 and for the specific elements recited therein. The additional of a third reference, namely Fischer, does not cure the aforementioned deficiencies of Yacobi in view Vaeth. That is, Fischer also fails to teach or suggest a registration server to allow access by a user, as recited in claim 13, from which claim 16 depends. Accordingly, claim 16 should be patentable over the cited art.

For the reasons described above, claims 8 and 16 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

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